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Paper No. 9

Barron K. Smith  
1318 W. Commerce  
Dallas, TX 75208-1401

**MAILED**  
**FEB 16 2011**  
**OFFICE OF PETITIONS**

In re Patent No. 6,450,864	:	
Issue Date: 09/17/2002	:	DECISION ON PETITION
Application No. 09/687,492	:	
Filed: 10/13/2000	:	
Title: END MILL GRINDER WITH TWO	:	
INDEPENDENTLY ADJUSTABLE GRINDING	:	
WHEELS	:	

This is a decision in response to the petition under 37 CFR 1.378(b), filed on September 28, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued on September 17, 2002. The second maintenance fee could have been paid during the period from September 17, 2009 through March 17, 2010, or with a surcharge during the period from March 18, 2010 through September 17, 2010. Accordingly, this patent expired on September 18, 2010, for failure to timely remit the second maintenance fee.

37 CFR 1.378(d) provides: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

The patent issued on September 17, 2002, in the name of inventor Raphael W. Smith. There is no record of an assignment of the patent rights. The present petition is signed by Barron K. Smith. Neither the papers submitted nor the records of the Office indicate that Barron K. Smith is the inventor or an attorney or agent registered to practice before the Office. Additionally, Barron K. Smith has not shown that he has the authority to act on behalf of Raymond W. Smith. Accordingly, it appears that the petition is improperly signed. Any renewed petition must be signed by inventor Raphael W. Smith or an attorney or agent registered to practice before the USPTO.

In the present petition, petitioner asserts that he mailed the second maintenance fee for this patent on September 9, 2010 to USPTO, PO Box 371611, Pittsburg, PA. Petitioner states that this was the address supplied to him by his attorney for a prior maintenance fee payment. Petitioner indicates that the correspondence was returned to him on September 21, 2010, with the annotation "Returned to Sender No Longer at This Address." Petitioner contends that he took reasonable care to ensure timely payment of the maintenance; however, he was not informed of the change of address. Petitioner provided the Office with a copy of a letter from Michael L. Diaz dated March 6, 2003, as well as a copy of a check payable to the "Director of U.S. Patent and Trade Office" in the amount of \$1,025.00 and dated September 9, 2010.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913).

In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure does not constitute “unavoidable” delay. Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of a patentee, and the patentee is bound by the consequences of those actions or inactions. Link v. Wabash Railroad Co., 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133. Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130 (D. Ind. 1987) (“If that attorney somehow breached his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He

cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. [Plaintiff] hired [the attorney] to represent him; [the attorney's actions must be imputed to him.]). The Office further notes that delay resulting from a lack of proper communication between a patent holder and a registered representative does not constitute unavoidable delay.

As previously stated, a showing of unavoidable delay may be met where patentee, or counsel for patentee, takes all action necessary to ensure the timely payment of the maintenance fee, but through the intervention of unforeseen circumstances, such as failure of facsimile, or the negligence of otherwise reliable employees, the payment is not timely received in the USPTO. In this instance, petitioner has not shown that all necessary actions were taken to ensure timely payment of the maintenance fee, and but for the intervention of unforeseen circumstances, the payment was not timely received in the USPTO. Rather, it appears that the circumstances petitioner finds himself are the result of a foreseeable consequence due to lack of diligence.

It appears that patentee relied on outdated information provided by his attorney in a letter dated March 6, 2003 (and annotated "6-06") instead of ensuring that the USPTO mailing address had not changed since the mailing of that communication. The Office reminds petitioner that he is bound by the actions or inactions of his chosen representative. Furthermore, patentee, as the owner of the patent, is ultimately responsible for the timely payment of the maintenance fee by undertaking the care and diligence observed by prudent and careful men in relation to his most important business. In this instance, the showing of record appears to be a lack of diligence on the part of patentee to obtain the correct mailing address by contacting the USPTO or performing a search of the USPTO's website. The Office reminds petitioner that the public was given notice of the change of address for payment of the maintenance fees in the Office Gazette as early as November 6, 2007, approximately 3 years before petitioner mailed his payment. Patentee's lack of knowledge of the new maintenance fee address and diligence in obtaining the most recent information does not support a showing of unavoidable delay.

Moreover, the Office notes that petitioner attempted to pay only \$1,025.00 for the second maintenance fee on September 9, 2010. The amount due on that date was \$1,305.00 (\$1,240.00 for the maintenance fee due at 7.5 years and a \$65.00 surcharge for late payment within 6 months). Assuming arguendo that the USPTO received the maintenance fee payment on September 9, 2010, the amount was insufficient to maintain the patent.

In view of the above, the petition is dismissed.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking further reconsideration is not refundable. Any request for refund should be in writing to the following address:

Mail Stop 16  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

In the alternative, petitioner may wish to request reconsideration in the form of filing a petition under 37 CFR 1.378(c), requesting that the Office accept the unintentionally delayed payment of the second maintenance fee. A petition under 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (i.e., the expiration date of the patent) and must include: (1) A statement that the delay in payment of the maintenance fee was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; and (3) payment of the \$1,640.00 surcharge set forth in 37 CFR 1.20(i)(2). **Petitioner may request that the \$700.00 surcharge previously paid be credited thereto leaving a balance due of \$940.00.**

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of fee address should be filed in accordance with Manual of Patent Examining Procedure, section 2540. The decision is being mailed to the address on the petition. However, the Office will mail all future correspondence solely to the address of record.

Copies of the forms for a Petition to Accept the Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) and a Change of Correspondence Address accompany the decision for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop Petition  
                              Commissioner for Patents  
                              P.O. Box 1450  
                              Alexandria, VA 22313-1450

By FAX:                   (571) 273-8300  
                              Attn: Office of Petitions

By hand:                  Customer Services Window  
                              Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

Telephone inquiries should be directed to the undersigned at 571-272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

Enclosures: Forms PTO/SB/66 and PTO/SB/123